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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,670	12/14/2000	Andreas Bleckmann	BEIERSDORF 6	2607

7590

11/26/2002

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-10

Office Action Summary

Application No. 09/719,670	Applicant(s) BLECKMANN ET AL.
Examiner LOVERING	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on APR. 2 & SEPT. 25, 2002.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 5-14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5-14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).
- *Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 5-9, 11, 12 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ansmann et al.

5,863,461 in view of Klier et al. 5,597,792.

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not*

Ansmann et al. (esp. Examples in column 3) disclose water-in-oil emulsions having 25% various oils (including white oil) including 0.1%-0.5% block copolyesters of PEG 600-300 and ricinoleic acid having 75% water. While Ansmann et al. do not specifically disclose a low viscosity of at most 5000 mPa's, it would have been obvious to one skilled in the art at the time applicants' invention was made to adjust the viscosity of the water-in-oil emulsions of Ansmann et al. to < 20 centistoke (which is < 5000 mPa's) which Klier et al. indicate is desirable (column 1, line 38 - column 2, line 61, esp. column 2, lines 30-40), e.g. by using a higher weight%, e.g. 2% of block copolyesters in the "emulsion concentrates" of Ansmann et al., noting that they contemplate up to 10% thereof (column 3, lines 9-12). [It is also noteworthy that Klier et al. (paragraph bridging columns 6 and 7, esp. column 7, line 15) are concerned with water-in-oil emulsions containing glycerol and/or polyglyceryl esters of natural fatty acids as surfactants.] Further as to claims 8 and 9 herein, Ansmann et al. (column 3, lines 4-12, esp. line 8) contemplate, and thus render prima facie

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obvious the use of 80% of aqueous phase. Further, as to claim 14 herein, the disclosure of Ansmann et al. that their emulsions are suitable for cosmetic applications (column 3, lines 13-19) would suggest to those having ordinary skill in the art their use in caring for the skin or hair.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. in view of Klier et al. as applied to claims 5-9, 11, 12 and 14 above, and further in view of Diec et al. WO 98/17238.

While the foregoing combination of Ansmann et al. and Klier et al. doesn't disclose the use of PEG-30 dipolyhydroxystearate as a surfactant or emulsifier, it would further have been obvious to one skilled in the art at the time applicants' invention was made to use as a surfactant or an emulsifier in the water-in-oil emulsions of Ansmann et al., modified as above by Klier et al., the PEG-30-dipolyhydroxystearate of Example ⁴5 of Diec et al. because the substitution of one old, well-known surfactant or emulsifier of the water-in-oil type for another is not of patentable significance.

4. Applicants' arguments filed September 25, 2002 have been fully considered but they are not deemed to be persuasive. While Klier et al. may be primarily interested in microemulsions, they are also concerned with emulsions, for example, in column 9,

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line 14 et sequa, wherein they state that, upon standing, their emulsions form at least two phases. Thus, the Examiner doesn't agree with applicants' assertion that emulsions and microemulsions are fundamentally different systems. In any event, it is self-evident that relatively low viscosities are desirable for use in application to the skin or hair manually as lotions or milks or by spraying as in aerosol preparations.

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

6. Claims 5-14 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 5-14 of copending Application No. 09/719,365. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
November 21, 2002

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP #1700